

### REMARKS

Applicants thank the Examiner for the thorough review of the application.

Claims 9-11, 15-35, 37-40, 45, 46, and 49-51 have been canceled as they are drawn to non-elected inventions. Claims 4, 5, 13, and 47 have been canceled without prejudice or disclaimer. Claims 1-3, 6-8, 12, 14, 36, and 41-44 have been amended. No new matter has been added by way of this amendment.

The specification was amended to correct typographical errors in the citations on page 3, lines 10-17, as suggested by the Examiner.

#### ***Rejection under 35 U.S.C. § 101***

Claims 41-44 are rejected under 35 U.S.C. § 101 because the Examiner asserts that the claimed recitation of a use results in an improper definition of a process. Claims 41-44 have been amended to be in proper form for method claims reciting steps involved in the process. Thus, Applicants respectfully request that this rejection to claims 41-44 be withdrawn.

Claims 1-8, 12-14, 36, 41-44, 47 and 48 are rejected under 35 U.S.C. § 101 as being drawn to non-statutory subject matter, since the claimed insecticidal protein is not isolated or purified. Claims 4, 5, 13 and 47 have been canceled making the rejection to these claims moot. Claims 1-3, 6-8, 12, 14, 36, 41-44 and 48 have been amended to recite that the claimed protein is isolated. In view of the amendment to claims 1-3, 6-8, 12, 14, 36, 41-44 and 48, Applicants respectfully request that this rejection under 35 U.S.C. § 101 be withdrawn.

#### ***Rejections under 35 U.S.C. § 112, first paragraph***

Claims 12, 36 and 47 are rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement. In particular, the Examiner asserts that the phrase "further protein" recited in claim 12 is not characterized in the specification. Claim 12 as amended is drawn to a synergistic combination comprising a protein of the instant

application and an insecticidal CRY protein. Support for this amendment can be found in original claim 13 and Example 9 of the specification.

The Examiner asserts that claim 36 is rejected because the specification does not describe how to interpret the values from the FASTA search, particularly how to interpret the significance of the “109” value. Applicants respectfully disagree.

Applicants respectfully submit that the FASTA analysis was well known to the skilled person at the time the instant application was filed as evidenced by the cited references (*See* Lipman & Pearson (1985) *Science* 227:1435-1441 and Pearson & Lipman (1988) *PNAS*. 85:2444-2448 cited at page 3 line 12-13 of the specification; and Smith & Waterman (1981) *Adv Appl. Math.* 2:482-489 cited at page 12, lines 21-23 of the specification). The skilled person would know that the higher the FASTA opt score, the higher the percentage identity between the sequences being compared. Given the knowledge of the skilled person at the time of filing and the teaching of the specification Applicants submit that the skilled person would recognize that the Applicants invented that which is claimed in claim 36.

The Examiner asserted that claim 47 does not satisfy the written description requirement because the structure of the protein must be correlated with its function. Claim 47 has been canceled making the rejection to this claim moot.

In view of the above amendments and remarks, Applicants respectfully request that the rejection to claims 12 and 36 under 35 U.S.C. § 112, first paragraph be withdrawn.

***Rejections under 35 U.S.C. § 112, second paragraph***

Claims 4, 5, 13, and 14 are rejected under 35 U.S.C. § 112, second paragraph because the Examiner asserts that the claims are indefinite. Specifically, the Examiner asserts that claims 4 and 5 broaden the limitation of claim 1. Claims 4 and 5 have been canceled making the rejection to these claims moot.


The Examiner further asserts that the word "combination" lacks antecedent basis in claims 13 and 14. Claim 13 has been canceled making the rejection to this claim moot. Claim 14 has been amended to recite the synergistic insecticidal-combination of claim 12. Therefore, Applicants respectfully request that the rejection to claim 14 be withdrawn.

#### CONCLUSION

In view of the above amendments and remarks, Applicants respectfully submit that this application is now in condition for allowance. Early notice to this effect is solicited. If the Examiner believes that a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned agent.

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Respectfully submitted,

  
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